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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,045	04/18/2001	Donald J. Mischo	MISCHO-1	2957
20606	7590	09/16/2004	EXAMINER	
KEITH FRANTZ 401 WEST STATE STREET SUITE 200 ROCKFORD, IL 61101			RODRIGUEZ, JOSEPH C	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Km

<b>Office Action Summary</b>	<b>Application No.</b> 09/838,045	<b>Applicant(s)</b> MISCHO, DONALD J.	
	<b>Examiner</b> Joseph C Rodriguez	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-44 is/are pending in the application.  
4a) Of the above claim(s) 10-23 and 42-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-28 and 30-41 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of claims 24-41 in the reply filed on June 25, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 10-23 and 42-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected claim grouping, there being no allowable generic or linking claim.

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-28 and 32-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Omann (US 5,451,003).

Regarding claims 24, 32-38, Omann teaches shredding the waste shingles to a specific size (col. 4, ln. 44-61; col. 6, ln. 27-36) and then separating said materials with a screen (68, 132; col. 6, ln. 58-63), wherein the material penetrating the screen can be regarded as fines with an asphalt-aggregate composition as the shredded waste shingles contain an aggregate layer (i.e., rock) (col. 1, ln. 36-48) and the materials not penetrating the screen can be regarded as the coarse material. Here, Applicant teaches that an asphalt-aggregate ratio can be established by setting a shredder size or a screen opening size, thus Omann can be interpreted as establishing and controlling an asphalt-aggregate ratio when teaching a shredder or a screen set to a specific size.

Regarding claims 25-28, 39-41, Omann teaches checking the ratio (i.e., gradation testing) of the material being processed and then adjusting the fine ratio (i.e., choosing appropriate screen size) (col. 6, ln. 35-63). Further, the shredding devices (38, 138) can be regarded as separation stations, wherein the addition of material, such as aggregate, with an optional third conveyor (col. 6, ln. 48-56) or the changing of the screen aperture size can be regarded as adjusting said separation rate.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3653

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mendenhall (US 4,095,284) in view of Omann (US 5,451,003).

Mendenhall teaches that it is known to crush and then separate asphalt-aggregate compositions into various size ranges, thus it is implicit from the use of a crusher and the selection of a size range that an asphalt-aggregate ratio has been established and then controlled (col. 1, ln. 10-29).

Mendenhall thus teaches all that is claimed except for expressly teaching this method applied to scrap asphalt shingles having an aggregate layer. Omann, however, teaches that it is known to process scrap asphalt shingles having an aggregate layer (col. 1, ln. 35-47; col. 4, ln. 44 et seq.). Moreover, Omann teaches that these types of asphalt shingles can be recycled for various uses and that a need still exists for processing these shingles to the cut size claimed by Applicant (col. 1, ln. 63-col. 2, ln. 22). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Mendenhall in view of Omann.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Omann (US 5,451,003) in view of Brock (US 5,201,472), Suzuki (JP 55142502 A) and what is well known in the art.

Omann teaches all that is claimed except for expressly teaching a specific ratio by weight and by volume. The mere choice of a ratio by weight or by volume, however, is well known in the art and Examiner takes Official Notice of such. Here, it is noted that aggregate ratios are known to relate to the material strength of certain substances (Suzuki, English Abstract), thus the mere selection of the ratio can not be regarded as novel when this ratio is a mere design choice related to the common variable of desired material strength. Further, Brock teaches that it is known to set and monitor the aggregate ratio by weight for better handling (col. 5, ln. 30-col. 6, ln. 48). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Omann as taught above.

#### ***Allowable Subject Matter***

Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is 703-

**308-8342.** The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).

The **UnOfficial** fax phone number for the organization where this application or proceeding is assigned is **703-306-2571** or **703-308-6552**.

The examiner's **UNOFFICIAL Personal fax number** is **703-746-3678**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see


<http://pair-direct.uspto.gov>

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (Toll Free).

Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **703-308-1113**.

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September 14, 2004

  
DONALD P. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600